

ATTORNEY DOCKET NO.
062891.0500

PATENT APPLICATION
09/735,739

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shantanu Sarkar, et al.
Serial No. 09/735,739
Filing Date: December 12, 2000
Group Art Unit: 2616
Confirmation No. 7468
Examiner: Shick C. Hom
Title: METHOD AND APPARATUS FOR USING AN EXTERNAL
TRANSCODER IN A COMMUNICATION SESSION

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Claims 1-5, 7, 9-13, 16-27, and 29-40 are pending and stand rejected in the Application. Applicants contend that the rejection of Claims 1-5, 7, 9-13, 16-27, and 29-40 on prior art grounds contain clear legal and factual deficiencies, as described below.

In a Final Office Action dated May 31, 2006 (hereinafter "Final Office Action"), Claims 1-5, 7, 9-13, 16-27, and 29-40 were rejected. Claims 1, 3, 10, 16, 23, 25, 30, 34-37, and 38-40 were rejected as being unpatentable over U.S. Patent No. 6,965,947 issued to Hild et al. (hereinafter "*Hild*") in view of U.S. Patent No. 6,785,223 issued to Korpi et al. (hereinafter "*Korpi*") and Claims 2, 4-5, 7, 9, 11-13, 17-22, 24, 26-27, 29, and 31-33 were rejected as being unpatentable over *Hild* and *Korpi* in view of U.S. Patent No. 6,731,625 issued to Eastep et al. (hereinafter "*Eastep*"). In a response to the Final Office Action dated July 19, 2006 (hereinafter "Response to Final"), Applicants provided remarks regarding the allowability of the pending claims. In an Advisory Action dated October 26, 2006 (hereinafter "Advisory Action"), the Examiner maintained the rejections of Claims 1-5, 7, 9-13, 16-27, and 29-40 as outlined in the Final Office Action and provided an additional explanation of the rejection. Applicants request a finding that these rejections are improper and request immediate allowance of the pending claims.

Independent Claim 1 is allowable because *Hild* and *Korpi*, alone and in combination, fail to disclose, teach, or suggest, explicitly or inherently, each limitation recited in Applicants' claims. For example, *Hild* and *Korpi* do not disclose "communicating protocol capabilities to the station in response to initiation of the call." The Examiner relies on *Hild* regarding this limitation. *Final Office Action*, pp. 4-5. The Examiner points to *Hild*'s process of "receiving a request from a client (step 600) . . . [T]he request includes a [document type definition], an application, a device, and a user in addition to an identification of the content desired by the client." Col. 5, ll. 56-59. Applicants contend that the rejection is not supported for the reasons described in the Response to Final at pages 11-12 under the heading "Section 103 Rejections." Particularly, the teachings of *Hild* regarding a request from a client do not disclose, teach, or suggest "communicating protocol capabilities."

As another example, *Hild* and *Korpi* do not disclose "initiating a transfer of the call to the transcoder to establish a first link between the station and the transcoder; and initiating

establishment of a second link with the transcoder to enable media exchange with the station using the protocol capability of the transcoder.” The Examiner acknowledges that *Hild* does not disclose this limitation and relies on *Korpi*. *Final Office Action*, pp. 5-6. Regarding this limitation, the Examiner points to *Korpi*’s “[p]rimary and secondary gatekeepers (104a, 106a) [that] establish a supervisory link (1b) with one another while the media connection is set up between client terminals (112a, 114a).” Applicants contend that the rejection is not supported for the reasons described in the Response to Final at pages 11-12 under the heading “Section 103 Rejections.” Particularly, the teachings of *Korpi* do not disclose, teach, or suggest “initiating a transfer of the call to the transcoder to establish a first link . . . and initiating establishment of a second link”

Because the Examiner has failed to establish a *prima facie* case for rejecting Claim 1, Applicants submit that Claim 1 should be allowed in addition to Claims 2-5, 7, 9-13, 16-27, and 29-40 for the same or analogous reasons of one or more of the above examples. Applicants’ arguments and amendments are without prejudice or disclaimer. By not addressing other rejections, statements, and/or arguments made by the Examiner, Applicants do not acquiesce to the Examiner’s additional rejections, statements, and/or arguments.

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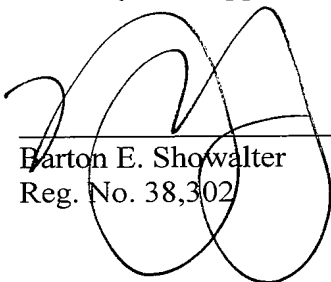
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CONCLUSION

As the rejection of Claims 1-5, 7, 9-13, 16-27, and 29-40 contain clear legal and factual deficiencies, Applicants respectfully request a finding of allowance of Claims 1-5, 7, 9-13, 16-27, and 29-40. To the extent necessary, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
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Date: Nov 16, 2006

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